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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,356	08/10/2001	Thomas D. Gordon	00537-188002	7156

37903 7590 08/31/2004

DAWN JANELLE AT  
BIOMEASURE INC.  
27 MAPLE STREET  
MILFORD, MA 01757

EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 08/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/868,356

Applicant(s)

GORDON ET AL.

Examiner

Brenda Coleman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,6,8 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,7,13,15,16,20 and 21 is/are rejected.
- 7) ☒ Claim(s) 9,10,12,14 and 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/16/04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application.

Claims 1-16 and 19-21 are pending in the application.

This action is in response to applicants' amendment dated June 16, 2004.

Claims 1 and 14 have been amended.

### ***Response to Arguments***

Applicant's arguments filed June 16, 2004 have been fully considered with the following effect:

1. The applicant's amendments are sufficient to overcome the improper Markush rejection of claim 14 labeled paragraph 2) in the last office action, which is hereby **withdrawn**.
2. The applicant's amendments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections of claims 5, 7, 9, 10, 12-14 and 19 labeled paragraph 6) in the last office action, which are hereby **withdrawn**.

In view of the amendment dated June 16, 2004, the following new grounds of rejection apply:

### ***Election/Restrictions***

3. Claims 3, 4, 6, 8 and 11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable

generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on May 15, 2003.

4. Claims 1, 2, 5, 7, 15, 16, 20 and 21 are rejected as being drawn to an improper Markush group. The recited compounds, while possessing a common utility, differ widely in structure and are not art-recognized equivalents and are thus, independently distinct for the reasons set forth in the restriction requirement. The Markush group represented by the variables  $R^3$  and  $R^{11}$ , where  $R^3$  and  $R^{11}$  can be taken together to form  $(R^{11})\text{---CH}_2\text{---S---S---C}(X^4)(X^5)\text{---}(\text{CH}_2)_{n2}\text{---}(R^3)$  have variably different definitions, rendering the claims clearly improper.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 1, 2, 5, 7, 13, 15, 16, 20 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

a) Claims 1, 2, 15, 16, 20 and 21 are vague and indefinite in that it is not known what is meant by the definition of  $R^6$  and  $R^7$ , where  $R^6$  and  $R^7$  are defined as an optionally substituted moiety selected from the group consisting of (C<sub>1-6</sub>)alkyl, (C<sub>2-6</sub>)alkenyl, (C<sub>3-6</sub>)cycloalkyl, (C<sub>3-6</sub>)cycloalkyl(C<sub>1-6</sub>)alkyl, (C<sub>3-6</sub>)cycloalkenyl, (C<sub>3-6</sub>)cycloalkenyl(C<sub>1-6</sub>)alkyl, aryl, aryl(C<sub>1-6</sub>)alkyl, heterocyclyl, and heterocyclyl(C<sub>1-6</sub>)alkyl wherein said optionally substituted moiety is optionally

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substituted with one or more substituents each independently selected from the group consisting of OH, (C<sub>1-6</sub>)alkyl, (C<sub>1-6</sub>)alkoxy, -N(R<sup>8</sup>R<sup>9</sup>), -COOH, CON(R<sup>8</sup>R<sup>9</sup>), and halo. The proviso at the bottom of page 5 limits R<sup>6</sup> to H when R<sup>7</sup> and R<sup>10</sup> are taken together to form a phenyl ring and R<sup>7</sup> to =O, -H and =S when R<sup>6</sup> and R<sup>10</sup> are taken together to form a phenyl ring.

b) Claims 1, 2, 5, 7, 15, 16, 20 and 21 are vague and indefinite in that it is not known what is meant by the definition of R<sup>30</sup> where R<sup>30</sup> is -NCO-R<sup>8</sup>. It is not known what else is bonded to the nitrogen atom, which only has two bonds.

c) Claims 1, 2, 5, 7, 15, 16, 20 and 21 are vague and indefinite in that it is not known what is meant by the definition of X<sup>1</sup>, X<sup>2</sup>, and X<sup>3</sup> where X<sup>1</sup>, X<sup>2</sup>, and X<sup>3</sup> is -NCO-R<sup>8</sup>. It is not known what else is bonded to the nitrogen atom, which only has two bonds.

d) Claim 13 is vague and indefinite in that it is not known what is meant by [1,2a] in the nomenclature of the species. It is believed that the applicants intended [1,2-a] as the species in claim 12 indicates.

e) Claim 20 is a substantial duplicate of claim 15 as the only difference is a statement of intended use, which is not given material weight. Note *In re Tuominen* 213 USPQ 89.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225

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USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 15 and 16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 10 and 14 of copending Application No. 10/129,569. Although the conflicting claims are not identical, they are not patentably distinct from each other because the complex compositions of Application No. 10/129,569 embrace the compositions and method of use of the compounds of the instant invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Objections***


7. Claims 9, 10, 12, 14 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 571-272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Brenda Coleman  
Primary Examiner Art Unit 1624  
August 27, 2004